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DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			YIGDALL, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2192	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,553

Applicant(s)

SATO, HIROTSUGU

Examiner

Michael J. Yigdal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119.

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to Applicant's submission filed on June 1, 2006. Claims 1-5 are pending.

Response to Arguments

2. Applicant's arguments have been fully considered but they are not persuasive.

Applicant contends that Tognazzini does not disclose, teach or suggest a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium (remarks, page 2, second paragraph, and page 4, first paragraph).

However, Tognazzini does teach a program for causing updated software to be stored in a memory device of a computer and in the optical recording medium (see, for example, column 5, lines 11-18). Applicant notes that Tognazzini discloses that the program "may be stored in ROM or RAM" (column 5, lines 24-26). Nonetheless, the program recited in the claims is not functionally distinct from the teachings of the references.

Mochizuki discloses software that is stored on the optical recording medium (see, for example, column 5, lines 29-35). Mochizuki does not disclose that the software stored on the optical recording medium includes a program for causing updated software to be stored in a memory device of a computer and in the optical recording medium. Tognazzini, however, teaches such a program, as noted above. Thus, Mochizuki in view of Tognazzini suggests a program stored on the optical recording medium for causing updated software to be stored in a memory device of a computer and in the optical recording medium.

Additionally, contrary to what Applicant implies (remarks, page 4, second paragraph), claim 5 does not recite such a program and does not recite any limitation as to where such a program would be stored.

Applicant makes general allegations that none of the cited references contain a suggestion or a motivation for their combination, that none of the references sets forth a reasonable expectation of success in their combination, that the Office action does not identify where a suggestion to combine the references exists or why a reasonable expectation of success of combining the references exists, and that the information contained in the current application is impermissibly used, in hindsight, to pick and choose features of the references to combine to arrive at the present invention (remarks, pages 2-3).

However, general allegations alone are not persuasive arguments. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Teachings, suggestions or motivations to combine the references, found in the references themselves or in the knowledge generally available to one of ordinary skill in the art, were presented in the Office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,097,814 to Mochizuki (art of record, "Mochizuki") in view of U.S. Patent No. 6,094,723 to Tognazzini (art of record, "Tognazzini") in view of U.S. Patent No. 6,535,911 to Miller et al. (art of record, "Miller").

With respect to claim 1 (previously presented), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see, for example, column 5, lines 15-21, which shows a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see, for example, column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information, and column 5, lines 56-67, which shows that the ID is permanent or non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see, for example, steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Mochizuki does not expressly disclose the limitation wherein the medium stores a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, and wherein said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium.

However, Tognazzini similarly discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Likewise, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Mochizuki and Tognazzini such that said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide

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the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

With respect to claim 4 (previously presented), the rejection of claim 1 is incorporated, and Mochizuki further discloses storing a computer information acquiring program for acquiring information of said computer (see, for example, column 6, lines 17-30, which shows obtaining a drive ID from the reproduction apparatus that is using the medium), wherein the transmission program transmits the information of the computer, as well as the inherent ID information, to the software distributor (see, for example, steps S1, S2 and S4 in FIG. 4, and column 7, lines 3-10, which shows transmitting the inherent ID of the medium and the drive ID or information of the computer to the software distributor).

5. Claims 2, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki in view of U.S. Patent No. 6,381,741 to Shaw (art of record, "Shaw") in view of Tognazzini in view of Miller.

With respect to claim 2 (previously presented), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see, for example, column 5, lines 15-21, which shows a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed and non-rewritable inherent ID information (see, for example, column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information, and column 5, lines 56-67, which shows that the ID is permanent or non-rewritable).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see, for example, steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see, for example, column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see, for example, column 5, lines 3-13), based on an authentication judgment result (see, for example, column 4, lines 34-42, which shows comparing a digital signature before beginning the update), after first transmitting ID information (see, for example, column 4, lines 13-18). Shaw further discloses that the updating program securely updates the data by performing integrity tests and confirming that the update is trustworthy (see, for example, column 1, line 66 to column 2, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information, such as taught by Shaw. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to securely update the software by performing integrity tests and confirming that the update is trustworthy.

Mochizuki in view of Shaw does not expressly disclose the limitation wherein the software updating program is for causing updated software to be stored in a memory device of a computer and in said optical recording medium, and wherein said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium.

However, Tognazzini similarly discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Likewise, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki and Shaw with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Mochizuki, Shaw and Tognazzini such that said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

With respect to claim 3 (previously presented), Mochizuki discloses an optical recording medium that is computer-readable and -writable (see, for example, column 5, lines 15-21, which shows a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable), which medium stores software to be distributed, non-rewritable inherent ID information (see, for example, column 5, lines 29-35, which shows that the medium stores software to be distributed and inherent ID information, and column 5, lines 56-67, which shows that the ID is permanent or non-rewritable), and a transmission program for transmitting the inherent ID information to a software distributor via a communication device (see, for example, steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see, for example, steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose a software updating program of rewriting and updating the software in accordance with update software transmitted from the software distributor via the

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communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see, for example, column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor (see, for example, column 5, lines 3-13), based on an authentication judgment result (see, for example, column 4, lines 34-42, which shows comparing a digital signature before beginning the update), after first transmitting ID information (see, for example, column 4, lines 13-18). Shaw further discloses that the updating program securely updates the data by performing integrity tests and confirming that the update is trustworthy (see, for example, column 1, line 66 to column 2, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki with a program for rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information, such as taught by Shaw. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to securely update the software by performing integrity tests and confirming that the update is trustworthy.

Mochizuki in view of Shaw does not expressly disclose the limitation wherein the software updating program is for causing updated software to be stored in a memory device of a computer and in said optical recording medium, and wherein said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium.

However, Tognazzini similarly discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Likewise, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the system of Mochizuki and Shaw with a program for causing updated software to be stored in a memory device of a computer and in said optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system of Mochizuki, Shaw and Tognazzini such that said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide

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the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

With respect to claim 5 (previously presented), Mochizuki discloses software distributed and stored in a computer-readable and -writable optical recording medium (see, for example, column 5, lines 15-21, which shows software distributed and stored in a computer-readable optical recording medium, and column 9, line 56 to column 10, line 8, which shows that the medium is writable).

Although Mochizuki discloses a method for reproducing software (see, for example, the title and abstract), Mochizuki does not expressly disclose a method of updating software. However, Shaw discloses a method of upgrading or updating software (see, for example, the title and abstract).

Mochizuki also discloses transmitting non-rewritable inherent ID information to a software distributor via a communication device (see, for example, steps S1 and S4 in FIG. 4, and column 7, lines 3-10, which shows that the ID stored on the medium is transmitted to a software distributor).

Although Mochizuki discloses reproducing the software based on an authentication judgment result of the inherent ID information (see, for example, steps S1, S4, S8 and S9 in FIG. 4), Mochizuki does not expressly disclose rewriting and updating the software in accordance with update software transmitted from the software distributor via the communication device based on an authentication judgment result of the inherent ID information.

However, Shaw discloses an updater or updating program (see, for example, column 4, lines 44-49) for rewriting and updating software with updated code transmitted from a distributor

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(see, for example, column 5, lines 3-13), based on an authentication judgment result (see, for example, column 4, lines 34-42, which shows comparing a digital signature before beginning the update), after first transmitting ID information (see, for example, column 4, lines 13-18). Shaw further discloses that the updating program securely updates the data by performing integrity tests and confirming that the update is trustworthy (see, for example, column 1, line 66 to column 2, line 10).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the method of Mochizuki with the step of rewriting and updating the software in accordance with update software transmitted from a software distributor via a communication device based on an authentication judgment result of the inherent ID information, such as taught by Shaw. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to securely update the software by performing integrity tests and confirming that the update is trustworthy.

Mochizuki in view of Shaw does not expressly disclose updating software in the computer-readable and -writable optical recording medium and in a memory device of a computer that is currently using the computer-readable and -writable optical recording medium, wherein said updated software is stored in said memory device of said computer, then said stored updated software is further stored in said optical recording medium.

However, Tognazzini similarly discloses an optical recording medium that is computer-readable and -writable (see, for example, column 2, lines 8-17). Tognazzini further discloses downloading and applying supplemental information or updates to the optical recording medium through a computer (see, for example, column 5, lines 11-18). Such information is stored in a

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memory device of the computer, and then stored in the optical recording medium (see, for example, column 6, lines 8-17).

Likewise, Miller discloses updating the software recorded on an optical recording medium (see, for example, the abstract, and column 2, lines 4-5). Miller further discloses downloading the updated software and storing the updated software on a storage device of the computer, so as to resume any incomplete transmissions and ensure that all files are downloaded before applying the update (see, for example, column 5, lines 62-67, and column 7, lines 52-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the method of Mochizuki and Shaw with the step of updating software in the computer-readable and -writable optical recording medium and in a memory device of a computer that is currently using the computer-readable and -writable optical recording medium, such as taught by Tognazzini. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to update a pre-recorded optical recording medium.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the method of Mochizuki, Shaw and Tognazzini such that said updated software is stored in said memory device of said computer, and then said stored updated software is further stored in said optical recording medium, as suggested by Miller. It would have been obvious because one of ordinary skill in the art would have been motivated to provide the ability to resume any incomplete transmissions and ensure that all files are downloaded before storing the updated software in the optical recording medium.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MY

Michael J. Yigdall
Examiner
Art Unit 2192

mjj



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SUPERVISORY PATENT EXAMINER